

REMARKS

The Applicants wish to thank the Examiner for thoroughly reviewing and considering the pending application. The Office Action dated March 17, 2006 has been received and carefully reviewed. Claims 1-18 are currently pending. Reexamination and reconsideration are respectfully requested.

Initially, the Applicants wish to thank the Examiner for allowing claims 13-16 and indicating that claims 10-12 include allowable subject matter.

The Office Action rejected claims 1,2,17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,298,678 to *Kim et al.* (hereinafter "*Kim*"). The Applicants respectfully traverse the rejection.

As required in Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of the claimed invention, all the limitations must be taught or suggested by the prior art." The Applicants respectfully submit that *Kim* fails to teach or suggest each and every element recited in claims 1,2,17 and 18. In particular, claim 1 recites an air conditioner comprising, among other features, a cabinet "having an insertion guide formed at a rear edge thereof." *Kim* fails to disclose or suggest this feature.

The Office Action, in fact, admits that *Kim* does not teach an insertion guide at a rear surface. Specifically, the Office Action alleges *Kim* discloses an insertion guide, but not an insertion guide at a *rear edge*. The Office Action attempts to overcome this deficiency in *Kim* by arguing that the location of the insertion guide is not critical. The Applicants respectfully disagree.

As may be seen in the specification at page 22, paragraph 88, lines 1-5, the criticality of the guide location at the rear edge is disclosed. More particularly, the specification states "the

insertion guide guides the base to be inserted into the cabinet” wherein “the base is loaded on the upper surface of the insertion guide”. Accordingly, the specification makes it clear that the location of the insertion guide at the rear edge is critical as it defines the relationship between the base and the cabinet. Therefore, the Examiner should not have ignored the “at a rear edge” claim language on the basis that is in an unimportant or insignificant limitation.

Further, in order to combine or modify teachings to obviate the invention, one of ordinary skill in the art must have been motivated to do so at the time the invention was made. The Office Action alleges that one of ordinary skill would have been motivated to modify *Kim* to include an insertion guide at the rear edge of the cabinet because it would “provide no better or improved performance over that which is commonplace in the art.” The Applicants respectfully disagree. Moreover, the Applicants believe the Examiner’s assertion proves just the opposite, that is, one of ordinary skill would not have been motivated to modify *Kim*. According to the Examiner, putting the insertion guide at the rear edge of the cabinet disclosed in *Kim* would “provide no better or improved performance.” So why would one of ordinary skill be motivated to modify *Kim* in such a way that would have no impact on performance. In fact, the Examiner’s assertion establishes a lack of motivation. Further, absent any evidence to the contrary, Applicants submit that “an insertion guide formed at a rear edge” is not considered commonplace in the art. If commonplace, Applicants respectfully submit that it should not be much of a burden for the Examiner to produce prior art that teaches the “at a rear edge” feature.

For at least the aforementioned reasons, claims 1, 17 and 18 are patentably distinguishable over *Kim*. Likewise, claim 2, which depends from claim 1 is also patentable for at least the same reasons as discussed above. Accordingly, Applicants request that the Examiner withdraw the rejection.

In addition, the Office Action rejected claims 1-5,17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,461,880 to *Bolton et al.* (hereinafter "*Bolton*") in view of *Kim*. The Applicants respectfully traverse the rejection.

The Applicants respectfully submit that neither *Bolton* nor *Kim*, either singularly or in combination, teach or suggest each and every element recited in claims 1-5,17 and 18. In particular, claims 1,17 and 18 recite an air conditioner comprising, among other features, a cabinet "having an insertion guide formed at the rear edge thereof." Neither of the references, either singularly or in combination, disclose or suggest this feature.

As correctly pointed out in the Office Action at page 3, *Bolton* does not disclose an insertion guide. *Kim* is introduced to overcome the deficiencies of *Bolton*, specifically to teach an insertion guide. However, *Kim* fails to teach or fairly suggest "an insertion guide formed at a rear edge", as explained above, nor would it have been obvious to modify *Kim* to include an insertion guide at a rear edge, as explained above. Because neither of the references, singularly or in combination teach all the claimed elements, the teaching of *Bolton* in view of *Kim* does not render the invention obvious.

Further, in order to combine the teachings of two or more patents, one of ordinary skill in the art must have been motivated to do so at the time the invention was made. Accordingly the Office Action asserts that the motivation to modify *Bolton* in view of *Kim* is to guide the insertion of the base into the cabinet. Applicants respectfully disagree.

The Applicants respectfully submit that *Bolton* cannot be modified by the teachings of *Kim*. *Bolton* discloses "the entire air conditioning unit 10 supported by a single piece base pan 42" (column 4, lines 44-45). Accordingly, the cabinet disclosed by *Bolton* is completely supported by the base pan and is stationary, thereby requiring no insertion. Therefore, one of

ordinary skill would not have been motivated to modify the invention taught by *Bolton* in view of *Kim* because there is no insertion required in *Bolton*, thus there is no need for an insertion guide.

For at least the aforementioned reasons, claims 1, 17 and 18 are patentably distinguishable over the combined teachings of *Bolton* and *Kim*. Similarly, claims 2-5, which depend from claim 1, are also patentable for at least the same reasons. The Applicants therefore request that the rejection be withdrawn.

Further, the Office Action rejected claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over *Bolton* in view of *Kim*. The Applicants respectfully traverse the rejection.

The Applicants respectfully submit that neither *Bolton* nor *Kim*, either singularly or in combination, teach or suggest each and every element recited in claims 7-9. In particular, claim 7 recites “an insertion guide formed at a lower portion thereof” and “the outdoor cover is detachable from the cabinet.”

The Examiner admits that *Bolton* does not teach an insertion guide. Therefore, *Bolton* can not possibly teach an “insertion guide formed at a lower portion....” Thus, the Examiner argues that it would have been obvious to modify *Bolton* by the teachings of *Kim*. Assuming *Kim* does teach an insertion guide at a lower portion, Applicants disagree that one of ordinary skill in the art would have been motivated to modify *Bolton* as suggested by the Examiner. As stated above, in *Bolton* the cabinet is completely supported by the base pan and is, as a result, stationary. Therefore, insertion is not required. Clearly, one skilled in the art would not have been motivated to modify *Bolton* in a way that is inconsistent with the cabinet design disclosed by *Bolton*.

Additionally, neither *Bolton* nor *Kim* disclose an outdoor cover “detachable from the cabinet”. The Office Action asserts that *Bolton* discloses a outdoor cover 36, detachable from the cabinet (see page 3). Nothing in the specification or drawings of *Bolton* explicitly teaches or suggests the cover can be removed from the cabinet. Further, the Examiner fails to explicitly point out in the specification where this limitation can be found. *Kim* also fails to teach or suggest an outdoor cover “detachable from the cabinet.”

For at least the aforementioned reasons, the Applicants respectfully submit that claim 7 is patentably distinguishable over *Bolton* in view of *Kim*, and request that the rejection be withdrawn. Likewise, claims 8 and 9, which depend from claim 7 are also patentable for at least the same reasons as discussed above.

The Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Bolton* and *Kim* in view of U.S. Patent No. 2,717,508 to *Loveley et al.* (hereinafter “*Loveley*”). The Applicants respectfully traverse the rejection.

As previously discussed, the combined teachings of *Bolton* and *Kim* do not teach or suggest all the features recited in claim 1, the base claim from which claim 6 depends. Moreover, *Loveley* does not address the shortcomings of *Bolton* and *Kim*, namely an air conditioner comprising, among other features, a cabinet “having an insertion guide formed at a rear edge thereof.” Therefore, the Applicants submit that claim 6 is patentable over the cited references and request that the rejection be withdrawn.

The application is in a condition for allowance and favorable action is respectfully solicited. If for any reason the Examiner believes a conversation with the Applicant’s representative would facilitate the prosecution of this application, the Examiner is encouraged to

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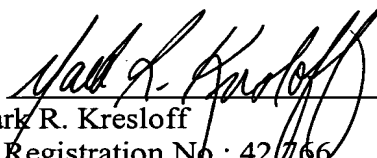
Docket No.: 7981.005.00-US

contact the undersigned attorney at (202) 496-7500. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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